

Remarks:

A. Introduction

Claims 1-15, 31, and 33-37 were pending and under consideration in the application.

In the Office Action of January 5, 2009, claims 1-15, 31, and 33-37 were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Claims 1-15, 31, and 33-37 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement.

Claims 1-6, 8-11, 13 and 31 were rejected under 35 U.S.C. §102(e) as being anticipated by Yamada, U.S. patent no. 6,897,440, (hereinafter, "*Yamada*")

As understood by Applicants, the remaining claims, claims 7, 12, 14, and 15, were rejected under 35 U.S.C. §103 as being unpatentable over *Yamada*. The Office Action, however, failed to expressly identify which claims were being rejected under §103 and failed to articulate for each claim the reason why the claimed invention would have been obvious.

In response, the claims are being amended for clarity and to obviate the §112 rejections by incorporating limitations disclosed in provisional application 60/477611 (incorporated by reference into the instant application at paragraph 001 of the instant application). No new matter is being added. Reconsideration of this application, as amended, is respectfully requested.

B. Rejections under 35 U.S.C. §102(e)

Claims 1-6, 8-11, 13 and 31 were rejected under 35 U.S.C. §102(e) as being anticipated by *Yamada*.

Yamada discloses a contact hole test device for measuring a thickness of a residual film on the bottom of a contact hole. *Yamada*, abstract. *Yamada* also relates to a method of testing a wafer to detect defective contact holes in a shortened time period without testing all of the contact holes *Yamada*, col. 1 lines 17-19.

Yamada fails to teach or suggest the high-current, high-throughput device as presently claimed having a beam current of approximately 10 μ amps, an inspection rate of at least 0.2 cm^2/sec , and an average noise current per contact opening less than 9 nA. On the contrary, *Yamada*, at most, provides that a wafer having a large number of contact holes may be divided into blocks, so that an electron beam is irradiated onto each block, so as to estimate which blocks have defective contact holes. *Yamada*, col. 39, lines 20-25.

A finding that a claim is anticipated requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because *Yamada* fails to disclose at least the features of the claims discussed above, claim 1 its dependent claims, claims 2-15, 31, and 33-37 are patentable over *Yamada*.

C. Rejections under 35 U.S.C. §103(a)

As understood by Applicants, claims 7, 12, 14, and 15 were rejected under 35 U.S.C. §103 as being unpatentable over *Yamada*.

Because dependent claims incorporate all the limitations of the claims from which they depend, claims 7, 12, 14, and 15 are patentable for the reasons given in Part B above.

In addition, as noted in the introduction, the Office Action failed to articulate for each claim the reason why the claimed invention would have been obvious to one of ordinary skill in the art at the time and thus failed to support a prima facie conclusion of obviousness with respect to claims 7, 12, 14, and 15. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. *In re Kahn* 441 F. 3d 977, 988 (Fed. Cir. 2006) MPEP 2141 III.

D. Conclusion

In view of the foregoing, it is submitted that claims 1-15, 31, and 33-37 are allowable and early notice to that effect is respectfully requested.

If the Examiner believes that, for any reason, direct contact with Applicants' attorney would help advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below, for purposes of arranging for a telephonic interview. Any communication initiated by this paragraph should be deemed an Applicant-Initiated Interview.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

By / Michael L. Day /

Michael L. Day, Reg. No. 55101

P.O. Box 061080

Wacker Drive Station, Sears Tower

Chicago, IL 60606-1080

415-882-5064 (telephone)

415-882-0300 (facsimile)

ATTORNEYS FOR APPLICANT